

Ex parte Oscar Meyer Foods Corp

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 30

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte OSCAR MEYER FOODS CORP.

MAILED

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PAT & TM OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Appeal No. 96-2596
Reexamination No. 90/003,185¹

HEARD: October 17, 1996

Before FRANKFORT, STAAB and McQUADE, Administrative Patent Judges.

STAAB, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 1, 3, 4, 8, 17, 20, and from the examiner's refusal to

¹Reexamination filed September 10, 1993. This is a reexamination of Application 06/600,702, filed April 16, 1984, now U.S. Patent No. 4,532,751.

Appeal No. 96-2596
Reexamination No. 90/003,185

allow claims 12-16, 23-26 as amended by an amendment filed on July 17, 1995 (Paper No. 21) subsequent to the final rejection.²

The examiner has confirmed the patentability of patent claims 2, 5-7 and 9-11. The examiner has also indicated as being allowable dependent claims 18, 19, 21, 22, 27 and 28, as amended during the reexamination proceeding.³ No other claims are pending.

The subject matter on appeal pertains, in its broadest aspect, to an apparatus (claims 12-15) and method (claim 23) for automatically forming "sheet products."⁴ The subject matter on appeal also pertains to an apparatus (claims 1, 3, 4, 8 and 16).

²The amendment of July 17, 1995 (Paper No. 21) has been entered. See the advisory letter mailed August 1, 1995 (Paper No. 22). The amendment filed on April 12, 1995 (Paper No. 17) subsequent to the final rejection has not been entered. See the advisory letter mailed May 16, 1995 (Paper No. 19).

³Dependent claims 18, 19, 21, 22, 27 and 28 are considered to be amended claims in that the base claim from which each ultimately depends has been amended during the reexamination proceeding.

⁴As used herein, the term "sheet product" denotes a substrate having individual products deposited thereon. See column 2, lines 54-57 of the specification ("Individual products 23, such as bacon slices, are deposited by the product conveyor assembly 21 onto pre-cut lengths of substrate 24, such as paper from the substrate supply assembly 22, in order to form sheet products 30.").

Appeal No. 96-2596
Reexamination No. 90/003,185

and method (claims 17, 20 and 24-26) for automatically forming -
and stacking "sheet products." Independent apparatus claim 12
and independent method claim 23 are illustrative of the subject
matter on appeal and read as follows:⁵

12. An apparatus for automatically forming sheet products,
comprising:

means for feeding a substrate web to a cutter assembly;

means for providing a conveyed flow of products consisting
of thin, flexible slices having a preselected spacing pattern
including a gap between a grouping of said products;

means for monitoring said conveyed flow of products and for
signaling said cutter assembly to sever the substrate web to a
pre-cut substrate length defined by severance gaps and to provide
the pre-cut substrate length to a substrate supply assembly in
timed sequence with said conveyed product flow means;

means for operatively intersecting said substrate supply
assembly and said conveyed product flow means, said timed
sequence being such that said grouping of products from the
conveyed product flow means is deposited onto said pre-cut
substrate length and such that said gap of the preselected
spacing pattern generally coincides with one of said severance
gaps, thereby forming a sheet product.

⁵Claims 12 and 23 have been reproduced in the manner
required by 37 CFR § 1.530(d) and 37 CFR § 1.121(f), that is with
matter deleted being placed between brackets and matter added
being underlined.

Appeal No. 96-2596
Reexamination No. 90/003,185

23. A method for automatically forming sheet products, comprising:

feeding a substrate web to a web cutting location;

providing a conveyed flow of products consisting of thin, flexible slices having a preselected spacing pattern including a gap between a grouping of said products;

monitoring said conveyed flow of products and signaling severance of the substrate web to a pre-cut substrate length defined by severance gaps;

providing the pre-cut substrate length to a substrate supply assembly in timed sequence with the conveyed flow of products; and

operatively intersecting the pre-cut substrate with the conveyed flow of products, said timed sequence being such that said grouping of products is deposited onto the pre-cut substrate length and such that the gap between the grouping of products generally coincides with one of the severance gaps, thereby forming a sheet product.

The references of record relied upon by the examiner in support of rejections under 35 U.S.C. § 102(b) and 35 U.S.C.

§ 103 are:

Lazott et al. (Lazott)	2,937,482	May 24, 1960
Lotz (Lotz '768)	3,296,768	Jan. 10, 1967
Divan	3,910,141	Oct. 7, 1975
Lotz (Lotz '277)	4,083,277	Apr. 11, 1978
Wagner et al. (Wagner)	4,236,855	Dec. 2, 1980

Appeal No. 96-2596
Reexamination No. 90/003,185

The following rejections are before us for review:⁶

(a) claims 12-15 and 23 under 35 U.S.C. § 103 as being unpatentable over Lotz '768 in view of Divan;

(b) claims 1, 3, 4, 8, 16, 17 and 24 under 35 U.S.C. § 103 as being unpatentable over Lotz '768 in view of Divan and further in view of Lotz '277;

(c) claims 20 and 26 under 35 U.S.C. § 103 as being unpatentable over Lotz '768 in view of Divan and Lotz '277, and further in view of Lazott; and

(d) claims 12, 15, 16 and 23-25 under 35 U.S.C. § 102(b) as being anticipated by Wagner.

The § 103 Rejections of Method Claims 17, 20, 23, 24 & 26

Based on Lotz '768 and Other References

Considering first the § 103 rejection of method claim 23 as being unpatentable over Lotz '768 in view of Divan, Lotz '768

⁶The rejection of claims 12-16 and 23-28 under 35 U.S.C. § 112, second paragraph, made in the final rejection has been withdrawn. See the paragraph spanning pages 1 and 2 of the answer.

Appeal No. 96-2596

Reexamination No. 90/003,185

pertains to an interleaving machine, i.e., a machine for placing a product onto a sheet of cellophane, wax paper, or the like.

The machine of Lotz '768 is intended specifically for interleaving prepared food items such as meat products (column 6, lines 58-62). The Lotz '768 machine includes "a product conveyor and sheet feeding mechanism under control of the product on the conveyor that both times the feed of the interleaving material and determines the length of the sheet to be severed therefrom, proportioning each to the individual product" (column 1, lines 35-39). To this end, the Lotz '768 machine comprises longitudinally aligned conveyors 7 and 8 with an intersection space between their aligned ends, and a substrate feeding and cutting assembly 14, 33, 34, 41, etc. for delivering a length of sheet material to the intersection space in timed sequence with the arrival of a product being conveyed by the conveyor 7. The substrate feeding and cutting assembly is under the control of a switch arm 67 mounted above the conveyor 7 upstream of the intersection space. The operation of the Lotz '768 is set forth in detail at column 4, lines 9-57. Basically, when the leading

Appeal No. 96-2596

Reexamination No. 90/003,185

end of a conveyed product engages the switch arm 67, feeding of sheet material commences and continues until the trailing end of the product disengages from the switch arm, whereupon the sheet material is severed by cutter blade 41.

Divan pertains to an apparatus "for slicing processed meat products, similar in section to bacon, and arranging the slices in shingled form on a continuously moving conveyor with separation between each draft of shingled slices" (column 1, lines 6-9). The Divan apparatus is controllable to arrange the slices in shingle fashion and segregate them into groups or drafts of any predetermined number of shingled slices (column 2, line 66 through column 3, line 2). Takeaway conveyor belt 36 runs at a faster speed than conveyor 10 to completely separate the drafts from each other on the belt 36 to thereby greatly facilitate handling and packaging of the drafts (column 3, lines 28-35).

Applying the test for obviousness set forth in *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981), which is what the combined teachings of the references would have suggested to

Appeal No. 96-2596
Reexamination No. 90/003,185

those of ordinary skill in the art, it is our conclusion that one having ordinary skill in the art would have found it obvious to utilize the interleaver machine of Lotz '768 in conjunction with the slicing apparatus of Divan for the purpose of interleaving an appropriately sized sheet of material under each draft of shingled slices of processed meat produced by the Divan apparatus. In this regard, we note that it is a common practice in the meat packing industry to package bacon as shingled slices placed upon a substrate of flexible sheet material. The resulting structure would necessarily function in accordance with the limitations of method claim 23, in our view. In particular, we consider that the switch arm 67 of the modified Lotz '768 machine would operate to sense the leading and trailing ends of each draft of shingled slices to signal the substrate feeding and cutting assembly to provide a sheet of interleaving material of a length that corresponds to the length of each draft. This would result in the steps of "monitoring . . . and signaling," "providing a pre-cut substrate length," and "operatively

intersecting" called for in the last three paragraphs of claim -
23.

We have considered all of the patent owner's arguments as they apply to method claim 23.⁷ However, we are not persuaded that the examiner's § 103 rejection of claim 23 is in error. In particular, we do not agree with the patent owner's argument on pages 11-15 of the main brief and pages 1-3 of the reply brief that when the terminology of claim 23, e.g., "sheet product" and/or "a grouping of said products," is interpreted in light of the specification, the claim must be read as excluding a substrate or grouping wherein the individual products are arranged in a shingled or aligned stack. Admittedly, the patent specification describes the invention in the context of an

⁷The argument in section A(2)(c) of the main brief regarding the proper interpretation to be given certain language appearing in the apparatus claims on appeal in light of *In re Donaldson Co.*, 16 F.3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994) has not been made with respect to the method claims on appeal. See page 22 of the main brief ("Further with respect to *apparatus claims 12-15*, the arguments in section A(2)(c) above with respect to the "means for monitoring . . . and for signaling" apply equally to the rejection of these claims over Lotz '768 in view of Divan, and are incorporated by reference here." (emphasis added)).

Appeal No. 96-2596
Reexamination No. 90/003,185

apparatus and method of forming and stacking groups of products deposited on substrates wherein the individual products on each substrate are spaced apart from each other. However, contrary to what the patent owner would have us believe, nothing in the patent specification defines "sheet product" or "grouping of products" as being limited to a sheet product or grouping where the individual products are separated by spaces. Furthermore, nothing in the patent disclosure indicates that the invention is limited to forming and stacking this type of sheet product. Accordingly, it is our view that the particular grouping of products referred to in the patent disclosure in describing the invention is exemplary rather than limiting. When considered in this light, our determination that the terminology of claim 23 does not preclude a shingled stack of individual products of the type disclosed by Divan is entirely *consistent* with the patent disclosure. In our view, what the patent owner would really like us to do here is to read a limitation from the specification into the claim which has no express basis therein. This is inappropriate, especially where, as here, the claims could have

Appeal No. 96-2596
Reexamination No. 90/003,185

been amended to provide express language for the coverage sought.

In re Yamamoto, 740 F.2d 1569, 1571-72, 222 USPQ 934, 936 (Fed. Cir. 1984); *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550 (CCPA 1969).

In a similar vein, the argument that Lotz '768 is not adapted for interleaving a sheet under "a grouping of spaced product . . ." (main brief, pages 13-14, emphasis added) fails at the outset because it is predicated on a limitation which does not appear in the claim. *In re Self*, 671 F.2d 1344, 1348, 213 USPQ 1, 5 (CCPA 1982). Rather, claim 23 merely sets forth the step of providing a flow of products having a spacing pattern including a gap between "a grouping of said products."

With respect to the argument on page 21 of the main brief that the apparatus of Lotz '768 is unsuitable for interleaving a substrate under a grouping of thin, flexible slices, such as the bacon slices of Divan, because the slices would tend to be bunched up by engagement with switch arm 67, we are apprised of no persuasive evidence of record to support such a contention. It is well settled that an attorney's argument in the brief

Appeal No. 96-2596
Reexamination No. 90/003,185

cannot take the place of evidence and that arguments of counsel, unsupported by competent factual evidence of record, are entitled to little weight. See *In re Payne*, 606 F.2d 303, 315, 203 USPQ 245, 256 (CCPA 1979) and *In re Pearson*, 494 F.2d 1399, 1405, 181 USPQ 641, 646 (CCPA 1974). Moreover, it is presumed that in following the teachings of the prior art, one of ordinary skill would exercise a certain amount of common sense. *In re Sovish*, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985); *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969). In utilizing the interleaving apparatus of Lotz '768 in conjunction with the slicing apparatus of Divan, one of ordinary skill in the art would not use a switch mechanism that would cause the products to bunch up on the conveyor.

The remainder of the patent owner's arguments, for the most part, point out individual deficiencies of the applied references (e.g., "In Lotz '768, a sheet is cut when the switch arm 67 disengages from each individual product. There is no grouping deposited on a pre-cut substrate." (main brief, page 15)).

However, nonobviousness cannot be established by attacking the

Appeal No. 96-2596
Reexamination No. 90/003,185

references individually when, as here, the rejection is predicated upon a combination of prior art disclosures. In re Merck & Co. Inc., 800 F.2d 1091, 1097, 231 USPQ 375, 380 (Fed. Cir. 1986).

In light of the foregoing, we will sustain the § 103 rejection of claim 23 as being unpatentable over Lotz '768 in view of Divan.

Turning to the § 103 rejection of method claims 17 and 24 as being unpatentable over Lotz '768 in view of Divan and further in view of Lotz '277, we observe that these claims generally include all the steps of claim 23 and that claim 24 adds the step of stacking the flow of sheet products into a stack of a plurality of sheet products, while claim 17 adds the step of reducing the rate of flow of sheet product, and the step of stacking the reduced rate of flow of sheet products into a stack of a plurality of sheet products. The examiner relied on Lotz '277 for a teaching of these additional steps. Lotz '277 pertains to a method of respacing chip steaks on a conveyor. In rejecting claims 17 and 24, the examiner correctly considered that "Lotz

Appeal No. 96-2596
Reexamination No. 90/003,185

'277 discloses a conveyor 16 which provides a flow of sheet product P having a gap between them. A shuttle conveyor 12 shuttles the sheet products P into two different streams for the purpose of dividing the original flow into two slower flows for stacking by two stackers 20" (answer, pages 17-18). The examiner than logically concluded that "[i]t would have been obvious . . . to have provided a product handling and stacking assembly similar to that of Lotz '277 for stacking the products exiting the conveyor 8 of Lotz '768" (answer, page 18). As to claim 17, the examiner further logically concluded that the rate of flow of the sheet products would be reduced, and the sheet products stacked, by the method of Lotz '277.

In addition to the arguments discussed above in our treatment of claim 23, the patent owner argues on page 16 of the main brief that Lotz '277 deals with individual products, or a stack of products that acts as an individual product, not a "sheet product." This argument is not well taken. At column 5, lines 26-32, Lotz '277 states that the description of the apparatus thereof "has also omitted mention of the practice of

Appeal No. 96-2596
Reexamination No. 90/003,185

interleaving chip steaks or groups of chip steaks with separation sheets which, of course, serve the purpose of preventing the stacked chip steaks from freezing together." At the very least, this statement would have suggested to one of ordinary skill in the art the obviousness of utilizing the Lotz '277 apparatus to stack sheet products comprising a plurality (i.e., "a grouping") of products.

As to the argument that the Lotz '277 apparatus would be unsuitable for handling sheet products (as called for in claim 17), or thin, flexible slices (as called for in claim 24) because the individual products on the substrate would tend to pile up because of the momentum driving them into the fence 26, we are once again apprised of no persuasive evidence of record to support such a contention. Accordingly, since the argument is unsupported by competent factual evidence of record, it is entitled to little weight. See *In re Payne*, 606 F.2d at 315, 203 USPQ at 256 (CCPA 1979) and *In re Pearson*, 494 F.2d at 1405, 181 USPQ at 646 (CCPA 1974). Moreover, in that one of ordinary skill is presumed to exercise a certain amount of common sense in

Appeal No. 96-2596
Reexamination No. 90/003,185

following the teachings of the prior art (*In re Sovish*, 769 F.2d at 743, 226 USPQ at 774 (Fed. Cir. 1985); *In re Bozek*, 416 F.2d at 1390, 163 USPQ at 549 (CCPA 1969)), in combining the reference teachings in the manner proposed one of ordinary skill would obviously not drive the conveyor sections 12 and 16 of Lotz '277 at a speed which would cause sheet products to pile up on the fence 26.

Concerning the patent owner's inference on page 17 of the main brief that impermissible hindsight has been employed because "as many as three references are combined," the criterion is not the number of references employed, but what they would have meant to a person of ordinary skill in the field of the invention. *In re Gorman*, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). In our view, the applied references reveal clear and unambiguous knowledge in the meat packaging art which, considered as a whole, would have been suggestive of the subject matter of the method claims.

In that the patent owner's arguments have not convinced us that the examiner erred in rejecting claims 17 and 24 under 35

Appeal No. 96-2596
Reexamination No. 90/003,185

U.S.C. § 103, we will sustain the standing § 103 rejection of these claims as being unpatentable over Lotz '768 in view of Divan and Lotz '277. We will also sustain the § 103 rejection of claims 20 and 26 as being unpatentable over Lotz '768 in view of Divan and Lotz '277 and further in view of Lazott since these dependent claims have not been separately argued apart from the claims from which they depend. See page 8 of the main brief.

*The § 103 Rejections of Apparatus Claims 1, 3, 4, 8 & 12-16
Based on Lotz '768 and Other References*

Each of the independent apparatus claims 1, 12 and 16 on appeal calls for:

means for monitoring said conveyed flow of products and for signaling said cutter assembly to sever the substrate web to a pre-cut substrate length defined by severance gaps and to provide the pre-cut substrate length to a substrate supply assembly in timed sequence with said conveyed product flow means.

With respect to the standing § 103 rejections of apparatus claims 1, 12 and 16, it appears to be the examiner's position that the microswitch 65 of Lotz '768 performs all the functions

Appeal No. 96-2596
Reexamination No. 90/003,185

of the claimed "means for monitoring . . . and signaling." The examiner further contends that (1) "[i]f appellant uses prior art structures to perform particular functions, then prior art structures in the references which perform substantially the same claimed functions are more likely to be reasonably interpreted as equivalents" (answer, page 22; emphasis in original); (2) "[t]he specification is broadly written so as to permit, and encourage, the broad interpretation of the broadly drafted claims that the examiner made in keeping with *In re Donaldson*" (answer, pages 30-31); and (3) "in Lotz '768 . . . there necessarily is a timed sequence in the feeding of the product and the feeding of the substrate for the product to intersect properly with the substrate. Gaps between the products must be timed to correspond with gaps between the substrates" (answer, page 31). Based on these considerations,⁸ the examiner appears to consider that the microswitch 65 of Lotz '768 is an "equivalent," in the 35 U.S.C.

⁸The examiner's remarks concerning "equivalents" found on pages 23-27 of the answer apply to Wagner, not Lotz '768.

Appeal No. 96-2596
Reexamination No. 90/003,185

§ 112 sixth paragraph sense, of the structure disclosed in the -
patent for performing the claimed function.

It is the patent owner's view that the "means for monitoring . . . and signaling" limitation of the apparatus claims must be interpreted in light of 35 U.S.C. § 112, sixth paragraph, as being limited to the corresponding structure, materials, or acts described in the specification of the patent undergoing reexamination and equivalents thereof (*In re Donaldson Company*, 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1849 (Fed. Cir. 1994)). The patent owner is further of the view that the microswitch 65 of Lotz '768 does not in any way correspond to the "means for monitoring . . . and signaling" described in the patent specification and is clearly not the equivalent thereof. In this regard, the patent owner notes that "the microswitch 65 [of Lotz '768] is no more than a simple two-pole on/off switch that is actuated by arm 67. It does not receive and process two signal inputs, as does controller 38 [of the patent]" (main brief, page 20).

Appeal No. 96-2596
Reexamination No. 90/003,185

The patent specification states at column 3, lines 5-22 that (1) detector assembly 36 puts out a "product coming" signal in response to one or more products 23 having passed under the photocell device 37 for detecting the presence of products 23 on the conveyor assembly 21, (2) rotary cam switch 35 puts out a "gap" signal in response to a predetermined amount of rotation of the line shaft 23, and (3) when the controller 38 receives both the "product coming" signal and the "gap" signal, the controller 38 provides a signal to the substrate web drive assembly 32 to feed the substrate to the cutter assembly 27, as well as a signal to the cutter assembly 27 to sever the thus fed substrate web 28. In light of this disclosure, it is our conclusion that the structure disclosed in the patent specification which performs the monitoring and signaling functions of the means-plus-function limitation in question is the combination of the controller 38, the detector assembly 36, 37, and the cam switch 35.

Looking now at Lotz '768, we see that solenoid 43, which retracts the sheet severing blade 41, and electric clutch brake 61, which actuates sheet feed roller 27, are supplied with

Appeal No. 96-2596
Reexamination No. 90/003,185

electrical power under the control of microswitch 65 (column 3, lines 69-75). When the arm 67 of the microswitch 65 is first contacted by the leading edge of a product on the conveyor 7, a solenoid 43 causes the cutter blade 41 to retract and the clutch brake to set the sheet feed rolls 26, 27 in motion (column 4, lines 14-24). When the trailing edge of the product passes from contact with the switch arm, the switch breaks contact with the result that the solenoid 43 is deenergized so that the cutter blade severs the sheet and the clutch brake 61 arrests the drive of the feed rolls (column 4, lines 28-34). The conveyor sections 7, 8 and the sheet delivering belts 33, 34 continue to run so that the interleaving sheet cut to proper length is interleaved with the product at the intersection of the conveyors 7 and 8 (column 4, lines 39-57). Thus, it is clear that the means for monitoring and signaling of Lotz '768 is not the same as the means for monitoring and signaling of the patent.

As to whether or not the structure disclosed by Lotz '768 is "equivalent" to the structure disclosed by the patent, as aptly pointed out by the patent owner on pages 19-20 of the main brief,

Appeal No. 96-2596
Reexamination No. 90/003,185

our present court of review in *Valmont Indus., Inc. v. Reinke Mfg. Co.*, 983 F.2d 1039, 1043, 25 USPQ2d 1451, 1455 (Fed. Cir. 1993) has stated that

an equivalent [in the context of the sixth paragraph of § 112] results from an insubstantial change which adds nothing of significance to the structure, material, or acts disclosed in the patent specification. . . .
"[T]he sole question" under section 112 involves comparison of the structure in the accused device which performs the claimed function to the structure in the specification.

Given (1) the court's view as expressed above, and (2) our determinations regarding the differences between the structure of the patent and the structure of Lotz '768 for performing the function in question, and (3) the patent owner's reasonable argument that the means for monitoring and signaling described in the patent specification is not the equivalent of the means for monitoring and signaling described in Lotz '768 because the microswitch of Lotz '768 does not receive and process two signal inputs as does the controller 38 of the patent, and (4) the examiner's view, with which we do not agree, that "[i]f appellant uses prior art structures to perform particular functions, then prior art structures in the references which perform

Appeal No. 96-2596
Reexamination No. 90/003,185

substantially the same *claimed* functions are more likely to be "reasonably interpreted as equivalents" (answer, page 22; emphasis in original), the examiner's conclusion that the microswitch 65 of Lotz '768 is the equivalent, in the § 112 sixth paragraph sense, of the structure disclosed by the patent for performing the claimed function is not well taken. In addition, the examiner does not contend, and it is not apparent to us, that the combined teaches of Lotz '768, Divan and/or Lotz '277 would have suggested to one of ordinary skill in the art the structure disclosed by the patent for performing the claimed function.

In view of the above, we will not sustain the § 103 rejection of apparatus claims 12-15 based on Lotz '768 in view of Divan, or the § 103 rejection of apparatus claims 1, 3, 4, 8 and 16 based on Lotz '768 in view of Divan and further in view of Lotz '277.

Appeal No. 96-2596
Reexamination No. 90/003,185

The § 102 Rejection of Claims 12, 15, 16 & 23-25

Based on Wagner

As indicated above, independent apparatus claims 12 and 16 each call for means for monitoring the conveyed flow of products and for signaling the cutter assembly to sever the substrate web to a pre-cut substrate length. Independent method claims 23 and 24 each similarly call for the step of monitoring the conveyed flow of products and signaling severance of the substrate web to a pre-cut substrate length.

In Wagner, the main motor 526 (M1) operates to drive the substrate feed rolls 54-56, 58-60, 66-68 and 70-72, as well as the product conveyors 26, 28, 32 and 34 (column 11, lines 59-64). Wagner provides sensors 546, 548 which span the conveyor 28 and have drag arms 547 and 549 which contact the articles being conveyed. The sensors operate pressure switches 542 and 544, which in turn control rheostats 538 and 540 that control the speed of the main drive motor 526 (M1) (column 12, lines 21-28). Wagner describes the relationship between the sensors and main drive motor as follows:

Appeal No. 96-2596
Reexamination No. 90/003,185

If and when the rate of delivery of the articles to the accumulator station D is too slow, sensor 548 actuates pressure switch 544 which controls rheostat 540 to slow the speed of the motor 526 (M1).

If and when the rate of delivery of the articles on conveyor 28 to the accumulator assembly D is too fast, sensor 546 activates pressure switch 542 which controls rheostat 538 to speed up motor 526. [column 12, lines 29-36]

In rejecting these claims as being anticipated by Wagner, the examiner has taken the position that the sensors 546, 548 function to monitor the flow of conveyed products and signal the cutter assembly to sever the substrate web to a pre-cut substrate length. As to the ability of Wagner's sensors 546, 548 to provide a signal for the severance of the substrate web to a pre-cut substrate length, the examiner states:

If the sensors determine that no products are flowing on the conveyor 30, the machine will stop and the substrate cutter would not cut a substrate. If the products slow down or speed up, the substrate cutter speed is adjusted accordingly, and these adjustments maintain timed sequence which allows the product grouping to intersect with the substrate so that the gaps between substrates corresponds [sic] with the gaps between product groupings as shown in Figure 3.
[answer, page 24]

Appeal No. 96-2596
Reexamination No. 90/003,185

Implicit in the above is the examiner's position that this operation of the sensors amounts to providing a signal to sever the substrate web to a pre-cut substrate length.

We cannot accept this position. While it is true that claims in a reexamination proceeding are to be given their broadest reasonable interpretation (*In re Yamamoto*, 740 F.2d at 1571-72, 222 USPQ at 936 (Fed. Cir. 1984)), this interpretation must be consistent with the specification and the claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. See *In re Bond*, 910 F.2d 831, 833, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990); *In re Sneed*, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983). Here, the examiner has unreasonably expanded the meaning to be given to the claim language calling for monitoring the conveyed flow of products and signaling severance of the substrate web to a pre-cut substrate length. Clearly, the sensors 546, 548 of Wagner provide a signal to control the speed of the main drive motor; they do not send a signal to sever the web. While we appreciate that the main motor has an effect on the operation of

Appeal No. 96-2596
Reexamination No. 90/003,185

the feed rolls of the substrate cutting assembly in the sense .
that the speed of the main motor determines the speed of the
substrate feed rolls, we do not think that the artisan,
consistent with the patent specification, would reasonably
construe Wagner's sensors as functioning in the manner required
by the patent claims. In this regard, the patent owner's
argument on page 6 of the reply brief that "[c]ausing the main
motor to speed up or slow down is not the same as signaling the
cutter assembly" is well taken. This constitutes a first reason
necessitating reversal of the § 102 rejection based on Wagner.

Furthermore, with respect to apparatus claims 12, 15 and 16,
even if we were to accept the examiner's position that the
sensors of Wagner operated in the manner called for in the
functional portion of the means for monitoring and signaling
limitation of these claims, we cannot agree with the examiner
that Wagner's sensors are the equivalent, in the § 112 sixth
paragraph sense, of the structure disclosed by the patent for
performing the claimed function. Given (1) the court's view as
expressed in *Valmont*, and (2) the difference in operation of the

Appeal No. 96-2596
Reexamination No. 90/003,185

structure described in the patent for performing the claimed function versus the sensors 546, 548 of Wagner⁹, and (3) the examiner's view, we which we do not agree, that if the structures of the invention that perform the claimed function are prior art structures, then the corresponding structures of the references are more likely to be interpreted as equivalents, the examiner's determination that the sensors 546, 548 of Wagner are the equivalent of the structure disclosed by the patent for performing the claimed function is not well taken. This constitutes an additional reason necessitating reversal of the § 102 rejection of apparatus claims 12, 15 and 16 based on Wagner.

In addition, it is unclear whether the patties P of Wagner constitute products consisting of thin, flexible slices, as called for in each of claims 12, 15, 16 and 23-25.

⁹The controller 38 of the patent receives and processes a "product coming" signal from the detector assembly 36, 37 and a "gap" signal from the cam switch 35 and outputs a signal directly to the cutter assembly only when both signals are received, whereas the sensors of 546, 548 of Wagner merely provide a "product coming" signal for setting the speed of the main drive motor.

Appeal No. 96-2596
Reexamination No. 90/003,185

In light of the foregoing, we will not sustain the § 102 .
~~rejection of claims 12, 15, 16 and 23-25 based on Wagner.~~

Summary

The § 103 rejection of claims 12-15 and 23 as being unpatentable over Lotz '768 in view of Divan is affirmed with respect to claim 23, but is reversed with respect to claims 12-15.

The § 103 rejection of claims 1, 3, 4, 8, 16, 17 and 24 as being unpatentable over Lotz '768 in view of Divan and Lotz '277 is affirmed with respect to claims 17 and 24, but reversed with respect to claims 1, 3, 4, 8 and 16.

The § 103 rejection of claims 20 and 26 as being unpatentable over Lotz '768 in view of Divan, Lotz '277 and Lazott is affirmed.

The § 102 rejection of claims 12, 15, 16 and 23-25 as being anticipated by Wagner is reversed.

The decision of the examiner is affirmed-in-part.

Appeal No. 96-2596
Reexamination No. 90/003,185

No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

AFFIRMED-IN-PART

Charles E. Frankfort
CHARLES E. FRANKFORT)
Administrative Patent Judge)

Lawrence J. Staab
LAWRENCE J. STAAB)
Administrative Patent Judge)

John P. McQuade
JOHN P. McQUADE)
Administrative Patent Judge)

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